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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,154	12/29/2000	Scott M. Frank	BS00-086	7629

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EXAMINER	
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ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,154	FRANK ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-4,10-16 and 35-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-4,10-16 and 35-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *20060407*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 1, 5-9, 17-34 have been cancelled and Claims 35-54 have been added; therefore Claims 2-4, 10-16, and 35-54 are currently pending in application 09/750,154.

Claim Rejections - 35 USC § 112

2. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 11, 35, 41, and 48 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.** Claims 11, 35, 41, and 48 disclose using licensing rights intellectual property utilization system to produce a licensing rights marketing opportunity score, however, the method/system used to determine the recommendation is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

4. The Specification describes a method for opportunity scoring (pgs. 174-175) and an IP marketing opportunity scoring system (pgs. 177-181). However, the specification fails to teach or disclose a licensing rights marketing opportunity score, the data that would be used for such a score or how the score would be analyzed to indicate positive or negative results. Therefore, one of ordinary skill in the art would not be able to re-create the

claimed invention with the ability to produce a licensing rights marketing opportunity score as claimed in the independent claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 2-4, 11-13, and 35-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,298,327 B1).**

7. As per **independent Claims 11 and 48**, Hunter discloses a method (computer readable medium) for determining whether to market licensing rights for an intellectual property asset, the method comprising: receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets (inventive disclosure), wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception); storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (Fig.2), wherein each intellectual property asset protection data records of the plurality of intellectual property asset protection data

records in the intellectual property asset protection database corresponds to at least one intellectual property asset; providing intellectual property asset protection data from at least one intellectual property asset protection data record in the intellectual property marketing opportunity system (Marketability analysis), including determining a market potential assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset, determining a marketing project timeframe assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset, determining a projected revenue potential assessment corresponding to the at least one intellectual property asset protection database for licensing rights for the intellectual property asset, determining a competitive threat assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset, and determining a marketing opportunity assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset based at least in part on the determined market potential assessment, the marketing project timeframe assessment, the projected revenue potential assessment, and the competitive threat assessment (C19-C22, Assessments and data included as part of the Marketability Analysis).

8. Hunter fails to expressly disclose determining, utilizing a computer system of the intellectual property marketing opportunity scoring system, an intellectual property licensing rights marketing opportunity score.
9. However, Hunter does disclose completing a marketability analysis on the intellectual property to determine a utilization (whether to patent and market) of said intellectual property/invention (C8 L11-18); Hunter further discloses wherein the marketability analysis includes licensing rights information (C9 L15-17); and finally, Hunter discloses wherein the system is used to determine a utilization for the invention and to assist in marketing the invention (C4 L21-32).
10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the determining includes generating an intellectual property licensing rights marketing opportunity score, as the marketability assessment would be useless without a concrete method of quantifying the results, in order to base a utilization/marketing decision.
11. As per Claims 12 and 49, Hunter discloses determining an intangible value assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset, wherein the marketing opportunity assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset is further based at least in part on the determined intangible value assessment (Evaluation of Market Value, C8 L11-17).

12. As per Claims 13 and 50, Hunter discloses determining that licensing rights for the intellectual property asset are to be marketed when the marketing opportunity assessment satisfies a predetermined threshold (C2, C8, worth the investment).

13. As per **independent Claims 35 and 41**, Hunter discloses a computer-readable medium containing a program for use in a computer (method) for determining whether to market licensing rights for an intellectual property asset, the program comprising the steps of: receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets (inventive disclosure), wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception); storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (Fig.2), wherein each intellectual property asset protection data records of the plurality of intellectual property asset protection data records in the intellectual property asset protection database corresponds to at least one intellectual property asset; providing intellectual property asset protection data from at least one intellectual property asset protection data record in the intellectual property marketing opportunity system; wherein the determining includes generating an assessment of the marketability of licensing rights for at least one intellectual property asset corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection

database (C9 L15-17, Gathering/assessing Licensing information), based at least in part on the intellectual property asset protection data *and on a criterion* (C9, based on innovation information and specific market information)

14. Hunter fails to expressly disclose determining by the intellectual property marketing opportunity scoring system an intellectual property licensing rights marketing opportunity score.

15. However, Hunter does disclose completing a marketability analysis on the intellectual property to determine a utilization (whether to patent and market) of said intellectual property/invention (C8 L11-18); Hunter further discloses wherein the marketability analysis includes licensing rights information (C9 L15-17); and finally, Hunter discloses wherein the system is used to determine a utilization for the invention and to assist in marketing the invention (C4 L21-32).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the determining includes generating an intellectual property licensing rights marketing opportunity score, as the marketability assessment would be useless without a concrete method of quantifying the results, in order to base a utilization/marketing decision.

17. Furthermore, while Hunter does not explicitly disclose wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will have a non-royalty impact on a marketer of the licensing rights of the intellectual property asset, Official Notice is taken that marketing analysis of Intellectual Property was well known at the time the invention was made, to include the assessment

between obtaining intellectual property protection and maintaining the intellectual property as an in-house trade secret (Coca-Cola's maintenance of soda formulations as Trade Secrets – decision determined by analyzing long-term impact of releasing formulas to public).

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will have a non-royalty impact on a marketer of the licensing rights of the intellectual property asset, in the system disclosed by Hunter, for the advantage of providing a system/program for determining whether to market an intellectual property (licensing rights), with the ability to increase the effectiveness of the system by incorporating a variety of business assessments (criterion) - in order to ensure the right decision is made.
19. As per Claim 2, Hunter discloses generating a marketing recommendation based at least in part on the generated assessment.
20. As per Claim 3, Hunter discloses wherein the marketing recommendation is an absolute recommendation based at least in part on a predetermined threshold.
21. As per Claim 4, Hunter discloses wherein the marketing recommendation is a relative recommendation based at least in part on a comparison of the generated assessment with one or more assessments of the marketability of the licensing rights of other intellectual property assets.
22. As per Claims 36-38 and 42-45, Hunter discloses generating an assessment of the marketability of the intellectual property asset based at least in part on the intellectual

property asset and on a criterion (C3 L1-26), and while Hunter fails to expressly disclose wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will give the customer a competitive advantage over the marketer of the licensing rights of the intellectual property asset, wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will increase a potential for future commercially advantageous transactions by the marketer of the licensing rights with the customer, wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will foster internal organization relations, and/or wherein the criterion includes a protection status associated with the intellectual property asset, Official Notice is taken that intellectual property marketing/business assessments were well known at the time the invention was made, to include the assessment techniques/criterions disclosed in claims 36-38 and 42-45.

23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the criterion includes whether marketing the intellectual property asset to a customer will give the customer a competitive advantage over the marketer of the intellectual property asset, wherein the criterion includes whether marketing the intellectual property asset to a customer will increase a potential for future commercially advantageous transactions by the marketer with the customer, wherein the criterion includes whether marketing the intellectual property asset to a customer will foster internal organization relations, and/or wherein the criterion includes a protection status associated with the intellectual property asset, in the system

disclosed by Hunter, for the advantage of providing a system/program for determining whether to market an intellectual property (licensing rights), with the ability to increase the effectiveness of the system by incorporating a variety of business assessments (criterion) - in order to ensure the right decision is made.

24. As per Claims 39 and 46, Hunter discloses determining that the licensing rights of the intellectual property asset are to be marketed when the generated assessment satisfies a predetermined threshold (C8, worth the investment of obtaining protection).

25. As per Claims 40 and 47, Hunter discloses determining that the licensing rights of the intellectual property asset is to be marketed based at least in part on a comparison of the generated assessment with one or more assessments of the marketability of licensing rights of other intellectual property assets.

26. **Claim 10, 14-16, and 51-54 are rejected under 35 U.S.C. 103 as being unpatentable over Hunter.**

27. As per Claims 10 and 54, Hunter does not expressly show wherein the criterion is selected from a marketing viability criterion, a potential customer criterion, a competitive criterion, a market potential criterion, a development criterion, an ownership criterion, a patent status criterion, an interest customer criterion, a deal complexity criterion, a time to closing criterion, a competitive advantage criterion, a future deals criterion, a customer relationship criterion, an internal political criterion, and a public relations criterion.

28. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be

performed regardless of the type of criterion used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a criterion selected from a marketing viability criterion, a potential customer criterion, a competitive criterion, a market potential criterion, a development criterion, an ownership criterion, a patent status criterion, an interest customer criterion, a deal complexity criterion, a time to closing criterion, a competitive advantage criterion, a future deals criterion, a customer relationship criterion, an internal political criterion, and a public relations criterion, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

30. As per Claims 14-16 and 51-53, Hunter does not expressly show wherein determining a marketing potential assessment step further includes determining a product viability assessment, a product marketing readiness assessment, and/or a projected total anticipated revenue assessment.

31. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of marketing assessment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

32. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a variety of industry common marketing assessments, to include: a product viability assessment, a product marketing readiness assessment, and/or a projected total anticipated revenue assessment, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention

Response to Arguments

33. Applicant's arguments filed 5/31/06 have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

36. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

August 3, 2006

Jonathan Ouellette
Patent Examiner
Technology Center 3600